

REMARKS

Claims 1-23 and 26-33 are pending. Claim 1 has been amended herein. Also, new claims 32 and 33 have been added. The subject matter amended to claim 1 regarding the glass transition point of the latex is supported by the present specification at page 59, lines 1-5. The fact that a polymer latex is used as a binder of the image-forming layer is supported by the present specification at page 57, lines 20-22. Concerning the rubber latex recited in new claim 32, the Examiner is referred to the description at page 59, lines 21-24 of the present specification. Thus, no new matter has been added.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, first paragraph

At pages 2 and 3 of the outstanding Office Action, the Examiner has asserted that the specification as originally filed fails to provide support for the limitation "SBR latex containing substantially no NH_4^+ " as presented in claim 1. Thus, the Examiner has rejected claims 1-23 and 26-31 as failing to satisfy the written description requirement. Applicant respectfully traverses this rejection.

In a previous response claim 1 was amended such that the recitation of "wherein the image-forming layer comprises a polymer latex containing substantially no NH_4^+ " now recites "wherein the image-forming layer comprises a SBR latex containing substantially no NH_4^+ ". In this regard, the Examiner must properly consider that the photographic film material of the present invention is defined such that it is not preferred that volatile bases such as ammonia exist in the films. Thus, condition I of the present invention specifies that the ammonium content in

all the layers formed on the image-forming layer side of the support be limited. This is specifically disclosed, for instance, in the paragraph bridging pages 25 and 26 of the present specification.

This disclosure is coupled with the preparation of the coating solution for the image-forming layer at pages 91-92. In particular, the binder is a SBR latex. Thus, the generic preferred understanding of substantially no ammonium is coupled with the specific example of a SBR latex. This certainly constitutes sufficient written description such that those skilled in the art would understand that the Applicant was in possession of the invention as claimed at the time of filing.

To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). That is, a patent specification must contain a written description of the invention sufficient to "allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) (quoting In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). Importantly, the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112, first paragraph. In re Lukach et al., 169 USPQ 795, 796 (CCPA 1971).

Thus, in the present instance, although the limitation in question is not described "word for word", this is immaterial since those of skill in the art, upon review of the present

specification, would understand that Applicant was in possession of this subject matter at the time of filing.

Further, Applicant submits that in addition to being incorrect, the Examiner has not shifted the burden of proof to Applicant. Insofar as the written description requirement is concerned, that burden is discharged by “presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” In re Wertheim et al., 191 USPQ 90, 97 (CCPA 1976). That is, if the specification contains a description of the claimed invention, albeit not *in ipsius verbis*, then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. Id. at 98.

In summary, Applicant submits that there exists sufficient written description for the pending claims. The Examiner is thus requested to withdraw this rejection.

Issues under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 1-23 and 26-31 under 35 U.S.C. § 112, second paragraph for the reasons recited at page 3 of the outstanding Office Action. In particular, the Examiner asserts that the claiming of “substantially no ammonium” in the context of a “SBR latex containing substantially no NH_4^+ ” is indefinite with respect to the amount of NH_4^+ . The Examiner’s rationale is that the specification fails to provide the meets and bounds of “substantially no NH_4^+ ”. Applicant respectfully disagrees.

The present specification also recites, at page 34, lines 8-13 “*[I]t is preferred that even a photothermographic material satisfying Conditions II should not substantially contain ammonia in the layers formed on the image-forming layer side of the support. [T]he expression of “not*

substantially containing ammonia" used herein means that ammonia is not intentionally added to each material or each coating solution." Thus, the polymer latex used in Examples was not intentionally added with ammonia, and it is explicit that the latex used in Examples did not substantially contain ammonia. Furthermore, as shown in the Oikawa Declaration (of record), using a polymer latex containing substantially no NH_4^+ can achieve the effects of the present invention, low fog, high Dmax (maximum density), less increase of fog during storage and little temperature and humidity dependency during development. On the other hand, using a polymer latex substantially containing NH_4^+ cannot achieve the effects of the present invention.

It is therefore apparent that the present specification specifically defines this limitation. The Examiner is thus requested to withdraw this rejection.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-16 and 18-31 under 35 U.S.C. § 103(a) as being obvious over JP '072 and Yamashita, U.S. Patent 6,071,687 (hereinafter referred to as Yamashita '687). Applicant respectfully traverses this rejection.

JP '072 and Yamashita fail to suggest or disclose the latexes as set forth in new claims 1 and 32. Yamashita is also silent regarding NH_4^+ .

As the Examiner points out, Yamashita discloses a SBR latex which has been purified by ultrafiltration until ionic conductivity was reduced from 4.2 to 1.5 mS/cm, which indicates a reducing ratio is $1.5/4.2 = 0.36$. However, as shown in the first NAKANO Declaration, according to JP '072, the amount of NH_4^+ in the image-forming layer was about 0.25 mmol/m^2 and Applicant submits that, even if the person skilled in the art would have combined JP '072 with Yamashita, the amount of NH_4^+ would have been reduced by 0.09 mmol/m^2 (0.25×0.36),

which is more than claimed range, 0.06 mmol/m².

The Examiner is thus requested to withdraw this rejection.

Lastly, the Examiner has rejected claim 17 under 35 U.S.C. § 103(a) as being obvious over JP '072 in view of Ito '310. Applicant traverses and submits that this rejection is moot for the same reasons already discussed above. The Examiner is thus requested to withdraw this rejection.

In view of the above remarks, it is believed that claims are allowable. Issuance of a Notice of Allowability is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig McRobbie, Reg. No. 42,874 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Application No. 09/928,339
Amendment dated May 1, 2008
Response to Office Action dated November 2, 2007

Docket No.: 2870-0171P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By  542.874

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